

REMARKS

At the time the present Office Action was mailed (December 19, 2005) claims 1-9, 34, 43, and 45-51 were pending, with claims 5-9 and 49-51 withdrawn. In the December 19, 2005 Office Action, claims 43 and 45-48 were allowed and the remaining claims were rejected. More specifically, the status of the application in light of this Office Action is as follows:

- (A) Claims 1, 4, and 34-42 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,873,872 to Gluckman et al. ("Gluckman");
- (B) Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gluckman in view of U.S. Patent No. 5,938,688 to Schiff ("Schiff"); and
- (C) Claims 43 and 45-48 are allowed.

The undersigned attorney wishes to thank the Examiner for engaging in a telephone interview on January 5, 2006. During the January 5 telephone interview, the pending claims and applied references were discussed. In light of arguments presented to the Examiner, the Examiner agreed that all the pending claims are allowable over the applied references. The following remarks summarize and expand upon the points raised during the January 5 telephone interview, reflect the foregoing agreement, and constitute applicants' interview summary.

A. **Response to the Section 102 Rejections**

As an initial matter, the undersigned attorney notes that the Gluckman reference was filed on October 11, 2002, which is after the February 7, 2002 filing date of the present application. Accordingly, the Gluckman reference is not prior art to the present application. However, applicants' attorney further notes that the Gluckman reference is a continuation-in-part of U.S. Application No. 09/729,929, now issued as U.S. Patent No. 6,665,562, and that the text in Gluckman '872 relied on by the Examiner for his claim rejections is also

contained in Gluckman '562. Accordingly, the following discussion with reference to "Gluckman" refers to Gluckman '562, not Gluckman '872.

Claim 1 is directed to a method of effectuating a neural-function in a patient, comprising selecting a stimulation site at the cortex of the patient where a change in an intrinsic, patient-specific neural-activity is suspected of occurring to carry out a particular physical and/or cognitive function. The intrinsic neural activity arises in association with a naturally occurring physiological process that facilitates at least partial recovery following neuralogic damage. The method further includes positioning an electrode at the selected stimulation site and applying an electrical signal to the stimulation site via the electrode.

Gluckman fails to anticipate claim 1 for at least the reason that Gluckman fails to disclose or suggest "selecting a stimulation site at the cortex of the patient where a change in an intrinsic, patient-specific neural-activity is suspected of occurring." For example, while Gluckman discloses the application of electrical stimulation to several neural systems, his primary emphasis is on suppressing epileptic seizures by breaking up seizure-like events with electrical signals (Gluckman, column 1, lines 9-10; column 2, lines 10-13, lines 25-26, and lines 61-62; and column 4, lines 53-55.) Gluckman further discloses specific examples that include generating seizure activity in a slice of tissue and then suppressing the seizure activity by applying electrical signals to the same tissue (see column 15, lines 22-47). When Gluckman discloses extending his stimulation technique to neural disorders other than epilepsy, he discloses applying an electrical field "to the particular brain region exhibiting the abnormal activity, e.g., cortex, hippocampus, thalamus, etc." (Gluckman, column 9, lines 57-59, emphasis added.)

By contrast, claim 1 of the present application includes "selecting a stimulation site at the cortex of the patient where a change in an intrinsic, patient-specific neural-activity is suspected of occurring." Accordingly, claim 1 includes selecting a stimulation site that is not necessarily where an abnormality is occurring but that is where a change in an intrinsic, patient-specific neural activity is suspected of occurring. In fact, in some cases,

the “abnormality” that an embodiment of a method having the features of claim 1 addresses is the fact that certain neural tissue is dead (e.g., in the case of a stroke). In such an instance, applying stimulation to the dead tissue would have no beneficial effect on the functionality of the tissue. In a specific example of such a case, the patient may have experienced a stroke involving the primary motor cortex, and selecting the stimulation site may include selecting a stimulation site at the pre-motor cortex (see, e.g., claim 4). For at least the foregoing reasons, Gluckman not only fails to disclose at least one feature of claim 1, but furthermore fails to suggest the features of claim 1. Accordingly, and as agreed to by the Examiner during the January 5 telephone interview, the Section 102 rejection of claim 1 should be withdrawn.

Claim 4 depends from claim 1. Accordingly, the Section 102 rejection of claim 4 should be withdrawn for the foregoing reasons and for the additional features of this claim.

Claim 34 includes features generally similar to those described above with reference to claim 1. Accordingly, the Section 102 rejection of claim 34 should be withdrawn for the foregoing reasons and for the additional features of this claim.

Claims 35-42 depend from claim 34. Accordingly, the Section 102 rejections of these claims should be withdrawn for the foregoing reasons and for the additional features of these claims.

B. Response to the Section 103 Rejection of Claim 2

Claim 2 was rejected under 35 U.S.C. § 103(a) on the basis of Gluckman and Schiff. Claim 2 depends from claim 1 and accordingly, the foregoing comments with respect to claim 1 apply to claim 2 as well. Furthermore, Schiff (which is directed generally to deep brain stimulation) fails to fill the void described above with reference to Gluckman as anticipating the elements of claim 1. Therefore, for the foregoing reasons and for the additional features of claim 2, the Section 103 rejection of claim 2 should be withdrawn.

C. Response to the Indication of Allowable Subject Matter

Claims 43 and 45-48 were indicated to be allowed. These claims have not been amended in this response.

D. Consideration of Withdrawn Claims

Claims 3, 5 and 49-51 are currently withdrawn and all depend from claim 1. In light of the Examiner's agreement that claim 1 is allowable over the applied references, dependent claims 3, 5 and 49-51 should now be considered and allowed.

E. Conclusion

In view of the foregoing remarks, all the pending claims are now in condition for allowance. If the Examiner is aware of any issues with regard to this application that can be expeditiously handled by a telephone interview, he is encouraged to contact the undersigned attorney at 206-359-3257.

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Respectfully submitted,

By


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